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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/738,930	12/17/2003	Steven E. Lenda	CFC-124-A	8474

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EXAMINER

RUDDOCK, ULA CORINNA

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 06/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/738,930

Applicant(s)

LEND A ET AL.

Examiner

Ula C. Ruddock

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 1-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 13-22 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/17/03 & 2/2/04</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-12, drawn to a method of forming a door shield, classified in class 156, subclass 60.
 - II. Claims 13-22, drawn to a vehicle door, classified in class 442, subclass 35.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product can be made by another method, i.e. by extruding the scrim and pad and using an adhesive to join the scrim and pad.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with William Hanlon, Jr. on June 6, 2005, a provisional election was made with traverse to prosecute the invention of Group I, claims 13-22. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-12 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 19 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 19 is indefinite because it is unclear how “the air permeability of the first layer is coordinated with the air permeability of the second layer to optimize sound absorption frequencies.” This claim appears to be vague.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 13-15, 17 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Thompson et al. (US 5,298,694). Thompson et al. disclose an acoustical insulating web and a

method for attenuating sound waves comprising a laminate of a nonwoven insulation web comprising thermoplastic fibers and a scrim layer. The laminate is adapted to be applied to the inner panel of a vehicle door (abstract). The nonwoven web comprises thermoplastic fibers and the scrim is a spunbond nonwoven scrim material, which will promote the integrity of the laminate (col 7, ln 41-46).

Claim Rejections - 35 USC § 102/103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claim 18 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Thompson et al. (US 5,298,694), as shown above. Thompson et al. Disclose the claimed invention except for the teaching that the first layer has an air permeability greater than zero. While Thompson et al. fails to disclose the claimed air permeability, it is reasonable to presume that said air permeability property is inherent to the Thompson et al. invention. Support for said presumption is found in the use of like materials (i.e. nonwoven spunbonded scrim and a nonwoven pad). The burden is upon Applicant to prove otherwise. *In re Fitzgerald*, 205 USPQ 594. In addition, the presently claimed property of an air permeability greater than zero would obviously have been present once the Thompson product is provided.

Note *In re Best*, 195 USPQ at 433, footnote 4 (CCPA 1977), as to the providing of this rejection made above under 35 USC 102.

Claim Rejections - 35 USC § 103

12. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Thompson et al. (US 5,298,694), as shown above, in view of Klaff (US 4,608,298). Thompson et al. disclose the claimed invention except for the teaching that the scrim comprises a polymeric apertured film.

Klaff (US 4,608,298) disclose a weather resistant and insulating textile comprising a thin film of perforated chemical resistant polymer (col 4, ln 1-10). It would have been obvious to one having ordinary skill in the art to have used Klaff's perforated film as the scrim in Thompson et al., motivated by the desire to create a laminate having increased resistance to water and/or chemicals.

13. Claims 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thompson et al. (US 5,298,694) in view of Potts et al. (US 5,149,576). Thompson et al. disclose the claimed invention except for the teaching that the nonwoven scrim is formed as a spunbond-meltblown-spunbond trilaminate and that the laminate further comprises a fluorocarbon or silicone additive.

Potts et al. (US 5,149,576) discloses a nonwoven laminiferous structure comprising two adjacent nonwoven layers and a scrim layer interposed therebetween (col 9, ln 3-9). An additive can be added to the laminate, including siloxane containing compounds (col 10, ln 24-28) and fluorine containing materials (col 12, ln 61-63). The laminate can comprise an SMS structure (col 16, ln 32-34). It would have been obvious to one having ordinary skill in the art to have used Potts' SMS structure as the scrim in Thompson et al., motivated by the desire to create a composite that

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couples the barrier properties of the meltblown web with the strength and abrasion resistance of spunbonded webs (col 16, ln 63-66). It also would have been obvious to have used the siloxane or fluorine containing additives of Potts on the web of Thompson, motivated by the desire to create web having water-wettability, antistatic properties, and alcohol repellency.

Conclusion

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ula C. Ruddock whose telephone number is 571-272-1481. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H. Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

UCR 


Ula C. Ruddock
Primary Examiner
Tech Center 1700